

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS**

In re _____)	JUL 28 1999 Decision on Petition for Regrade Under 37 C.F.R. § 10.7(c)
)	
)	
)	
)	

MEMORANDUM AND ORDER

Petitioner) petitions for regrading his answers to questions 1, 3, 4, 5, 7, 9, 10, 16, 22, 23, 25, 27, 30, 35, 37, 39, 43, and 46 of the afternoon section of the Registration Examination held on August 26, 1998. The petition is denied to the extent Petitioner seeks a passing grade on the afternoon section of the Registration Examination.

BACKGROUND

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 64 on the afternoon section. On December 29, 1998, Petitioner requested regrading of nineteen two-point questions on the afternoon section, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Commissioner.

OPINION

Under 37 C.F.R. § 10.7(c), Petitioner must establish any errors that occurred in the grading of the examination. The directions state: "No points will be awarded for

incorrect answers or unanswered questions.” The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the afternoon section state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is “All of the above,” the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO,” “PTO,” or “Office” are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of Petitioner’s arguments have been considered.

Question 1 reads as follows:

1. Dr. John Doe, an electrical engineer, was employed by the General Automotive Company (GAC), to do research on ignition distribution systems for internal combustion engines. In the course of such research, Dr. Doe took a number of samples of rigid metallic manifold casings, and filled them with a variety of yieldable, non-moldable unitary solids having various dielectric properties. After testing many materials including the reaction products of polymerized walnut-shell oil and formaldehyde, and comparing their radio shielding properties, none of which worked, Dr. Doe concentrated his research on what theoretically appeared to be the most promising materials, specifically, the reaction products of polymerized

nut-shell oil and formaldehyde. Included in Dr. Doe's subsequent tests were the polymerized oils from the shells of walnuts, peanuts, chestnuts, almonds, and cashews only. In the case of the cashews, Dr. Doe discovered that the dielectric property of the resulting reaction products were such that when utilized in harnesses designed for ignition distribution systems of internal combustion engines the radio shielding property proved outstanding. As patent counsel for GAC, you prepared and filed in the PTO a patent application disclosing the results of Dr. Doe's research including his test data. The application as filed includes a single claim which begins with the following language:

A radio-shielding harness for the ignition distribution system of an internal combustion engine, comprising a rigid metallic manifold casing for enclosing and shielding a plurality of ignition conductors, and

Which of the following phrases, each of which is described by the specification, when added to the end of the recited claim language is least likely to be rejected under 35 U.S.C. § 112?

- (A) a solid yieldable dielectric material consisting of polymerized nutshell oil substantially filling said casing around said conductors, said material being in a non-moldable state and capable of holding said conductors against movement relative to each other and to the casing.
- (B) a solid yieldable dielectric material consisting of the reaction products of polymerized nut-shell oil and formaldehyde substantially filling said casing around said conductors, said oil selected from the group comprising shells of walnuts, peanuts, chestnuts, almonds, and cashews, and said material being in a non-moldable state and capable of holding said conductors against movement relative to each other and to the casing.
- (C) a solid yieldable dielectric material consisting of the reaction products of polymerized nut-shell oil and formaldehyde substantially filling said casing around said conductors, said oil selected from the group consisting of shells of walnuts, peanuts, chestnuts, almonds, and cashews, and said material being in a non-moldable state and capable of holding said conductors against movement relative to each other and to the casing.
- (D) a solid yieldable dielectric material consisting of the reaction products of polymerized cashew-shell oil and formaldehyde substantially filling said casing around said conductors, said material being in a non-moldable state and capable of holding said conductors against movement relative to each other and to the casing.

- (E) a solid yieldable dielectric material selected from the group comprising the reaction products of polymerized chestnut-shell oil and formaldehyde substantially filling said casing around said conductors, said material being in a non-moldable state and capable of holding said conductors against movement relative to each other and to the casing.

Choice (D) is correct for at least two reasons. First, choice (D) is the only choice supported by an enabling disclosure as required by 35 U.S.C. § 112, first paragraph. The disclosure indicates that the reaction products of polymerized cashew-shell oil and formaldehyde proved outstanding for the intended purpose. However, many other materials were tested, including the reaction products of polymerized walnut-shell oil, but none worked. Materials other than the reaction products of cashew-shell oil and formaldehyde merely “theoretically appeared” to be promising. Second, choice (D) corresponds in scope with that which the Petitioner regards as his invention. The second paragraph of 35 U.S.C. § 112 states: “The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”

Petitioner contends that choice (C) is more correct than choice (D) “because the given answer ‘D’ is more likely to be rejected under Section 112 than the Petitioner’s answer ‘C’.” According to Petitioner, “the answer in ‘C’ is superior because the claim in ‘D’ is too narrowly drawn, limited to using cashew shell oil only, whereas the claim in ‘C’ is more broad and therefore a better claim, being extended to various types of oils; and the broaders [sic] claims of ‘C’ are adequately supported in the disclosure and therefore not properly rejectable under Section 112.” Petitioner then inconsistently argues that “[t]here is no basis at all for rejection of ‘D’ under Section 112.” Petitioner further maintains that

“[a]t best, this question calls for subjective inference rather than being an objective answer.”

Petitioner’s arguments are not persuasive. Petitioner first contends that “answer ‘D’ is more likely to be rejected under Section 112 than Petitioner’s answer ‘C’.” However, Petitioner provides no reasons that explain how choice (D) might be rejected under Section 112 or any other statute, and then admits that “[t]here is no basis at all for rejection of ‘D’ under Section 112.” Choice (C) is wrong because it is likely to be rejected under Section 112, first paragraph. The polymerized nut-shell oils listed in choice (C) include walnut-shell oil and others, but according to the facts provided “none of [these] work.” While the patent application disclosing these results is enabling for the polymerized cashew-nut shell oil material, it does not reasonably provide enablement for the other materials listed. Thus, choice (C) is not commensurate in scope with the enabling disclosure. See MPEP 2164.08. Contrary to Petitioner’s argument that “the claim in ‘C’ is more broad and therefore a better claim, being extended to various types of oils,” choice (C) is more likely to be rejected under Section 112 because its scope or breadth is not supported by an enabling disclosure. Petitioner fails to establish how this question is “patently subjective, ambiguous and obviously unfair.” No error in grading has been shown. Petitioner’s request for credit on Question 1 is denied.

Question 3:

Two points are awarded for question 3.

Question 4 reads as follows:

4. Star Chemical Corporation retains you to obtain patent protection for their invention relating to improved production of ethylene oxide. You prepare and file a patent application in the PTO having a specification

satisfying the requirements of 35 U.S.C. § 112 and the following two claims, which are fully supported by the specification:

1. A process for preparing a silver-supported catalyst for the improved production of ethylene oxide, said process comprising the steps of:

- (a) forming an aqueous solution of silver salt;
- (b) immersing completely in said solution a carrier of inert, porous particles, characterized by an average diameter not larger than 3/16 inch, an average pore diameter of 10 to 70 microns, and a surface area less than one square meter per gram;
- (c) impregnating said particles with said solution;
- (d) separating the impregnated particles from the remainder of said solution;
- (e) drying the separated particles, whereby said silver salt is deposited uniformly throughout the pores of said particles; and
- (f) activating the dried particles by heating them in air at a temperature sufficient to decompose the deposited silver salt.

2. An oxygen-activated catalyst for use in the controlled catalytic oxidation of ethylene to ethylene oxide, said catalyst comprising 5 to 25% by weight of silver, said silver being the thermal decomposition product of a pore solution-deposited silver salt uniformly distributed throughout the pores of inert, porous particles.

Claim 1 is rejected in the first Office Action under 35 U.S.C. § 103 as unpatentable over Able in view of Baker. Claim 2 is rejected under 35 U.S.C. § 103 as unpatentable over Baker. Able discloses a process for producing a catalyst for oxidation of ethylene to ethylene oxide by impregnating a porous carrier with a solution of a silver salt of an organic acid, separating the excess liquid, drying the impregnated carrier, and decomposing the silver salt by direct heat in an inert gas. Baker discloses a method of making an oxygen activated catalyst by coating a carrier with a silver catalyst using a paste or slurry. The silver compound paste is coated on the support, dried and then activated by treating the catalyst in large trays for several hours in a forced draft hot air oven at about 400°C. Baker discloses the physical characteristics of the oxygen-activated catalyst. The physical characteristics of the claimed catalyst are indistinguishable from Baker's catalyst.

Which of the following represents the best course of action to overcome the rejection and obtain a Notice of Allowance in the application?

- (A) Cancel Claim 1 and argue that the inventive catalyst has both high selectivity, i.e., a measure of the ability of a catalyst to prefer the partial oxidation reaction of ethylene over the total oxidation reaction of ethylene to carbon dioxide, and high productivity, i.e., a measure of the amount of ethylene oxide produced per unit of catalyst and per unit of time.
- (B) Cancel Claim 2 and argue that the combination of references is improper because it would not have been obvious to one of ordinary skill in the art to substitute the activation step of Baker for the activation step of Able.
- (C) Amend Claim 1 to recite that an oxidizing agent is added to the solution to prevent premature reduction of the silver salt.
- (D) Cancel Claim 1 and amend Claim 2 to recite that the inert, porous particles contain silica-alumina, and argue that such recitation is not disclosed by the references.
- (E) Cancel Claim 1 and argue that the combination of references is improper because it would not have been obvious to one of ordinary skill in the art to substitute the activation step of Baker for the activation step of Able.

Choice (B) is the most correct answer because cancellation of Claim 2 leaves only process Claim 1 which involves (i) impregnation of a carrier with a silver salt deposited from solution, and (ii) an activation step involving heating in air. While Able teaches step (i), his activation step involves heating in an inert gas, whereas Baker teaches step (ii), but his impregnation step involves impregnation of a carrier with a silver salt by coating the carrier with a paste or slurry. There is no suggestion in the references to arbitrarily select Able's step (i) and Baker's step (ii) and combine them to arrive at the inventive process. *In re Brown*, 459 F.2d 531, 534, 173 USPQ 685, 687 (CCPA 1972) (catalyst activation step using inert gas teaches away from combination with reference using air). Choice (B) overcomes the rejection of the product-by-process Claim 2 by cancellation.

Petitioner contends that choice (D) is more correct than choice (B) because “(1) the arguments of answer ‘B’ do not suffice to traverse the references (2) the answer key answer is not the best answer (3) D is a clearly better answer than B (4) the distinction

between ‘B’ and ‘D’ is not apparent or is at best subjective and is therefore not a proper subject of examination.”

Petitioner’s arguments are not persuasive. Petitioner describes the traversal presented in choice (B) as insufficient but fails to provide any facts or reasoning to support his position. The facts in this question were based on the case cited above, in which the court found the traversal presented in choice (B) dispositive of nonobviousness. Choice (D) is not the most correct answer because the product-by-process claim remains in the application, in plain contrast to choice (B). Since the patentability of such a claim does not depend on its method of production, and the product is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Brown*, 459 F.2d at 535, 173 USPQ at 688 (“[W]hen the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable”); *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (“[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself”); MPEP § 2113. Thus, choice (D) is not the best strategy for overcoming the rejection. No error in grading has been shown. Petitioner’s request for credit on Question 4 is denied.

Question 5:

Two points are awarded for question 5.

Question 7 reads as follows:

7. Inventor Jones received a patent that, through error and without deceptive intent, failed to describe an embodiment of her invention. Eighteen months after the patent was issued, you filed a complete reissue application adding a claim directed to the omitted embodiment, together with Jones' declaration explaining the error, and the other required papers. In accordance with PTO practice and procedure,

- (A) The claim is subject to a rejection under 35 U.S.C. § 132.
- (B) The specification is subject to an objection as failing to provide proper antecedent basis for the claimed subject matter and require correction.
- (C) The claim is subject to a rejection under 35 U.S.C. § 251 and a rejection under 35 U.S.C. § 112, first paragraph.
- (D) The claim is allowable.
- (E) (B) and (D).

Choice (C) is the most correct answer because the amendment claiming the omitted embodiment is new matter. MPEP § 1411.02. Choices (B) and (D) are incorrect because Jones did not describe the omitted embodiment in the original patent. Thus, choice (E) is incorrect.

Petitioner contends that choice (E) is a more correct answer than choice (C) "because (1) the question is fundamentally ambiguous, subjective and unfair (2) 'C' is not the only basis for rejecting Jones' invention, since it is also objectionable for failure of antecedent basis of the claimed subject matter--the omission of the disclosure cannot be cured EIGHTEEN MONTHS LATER by a declaration of the inventor, nor can the error possibly be cured at that late date by a mere declaration of inadvertence. If the Office intends this to be the rule, then I'd like to see at least one recent case where this was cured in such a fashion. (3) 'E' is the more correct answer because the proper procedure here would be to reject based on 'B'. The claim would be allowable if filed with a specification that adequately disclosed."

Petitioner's arguments are not persuasive. Petitioner fails to demonstrate how "the question is fundamentally ambiguous, subjective and unfair." Choice (B) provides merely an objection and an unfounded requirement for correction. In this situation, correction is not possible. MPEP § 1411.02 provides that "[n]ew matter, that is, matter not present in the patent sought to be reissued, is excluded from a reissue application in accordance with 35 U.S.C. § 251." MPEP § 1411.02 further provides that a claim drawn to new matter should be rejected under 35 U.S.C. § 112, first paragraph. Thus, the correction required in choice (B) is unfounded because it violates the statute prohibiting new matter. Thus, choice (B) is not a correct answer. Choice (D) is incorrect because Jones did not describe the embodiment in the original patent. Choice (E) refers to both choices (B) and (D). Petitioner's statement that "the proper procedure here would be to reject based on 'B'" is without merit and is inconsistent with selecting choice (D) as also correct. No error in grading has been shown. Petitioner's request for credit on Question 7 is denied.

Question 9 reads as follows:

9. In the course of prosecuting a patent application before the PTO, you receive a non-final Office action allowing Claim 1, and rejecting Claims 2 through 6, the remaining claims in the case.

Claim 1 reads as follows:

1. A ship propeller exhibiting excellent corrosion resistance, said ship propeller consisting essentially of a copper base alloy consisting of 2 to 10 percent tin, 0.1 to 0.9 percent zinc, and copper.

The specification of the application teaches that the copper base alloy made with the addition of 2 to 10 percent aluminum increases the alloy's wear resistance without detracting from its corrosion resistance. However, adding aluminum to the surface of the propeller does not increase wear resistance. Which of the following claims, if any, if added by amendment would accord with proper PTO practice and procedure?

- (A) 7. A copper base alloy according to Claim 1 wherein said alloy includes 2 to 10 percent aluminum.
- (B) 7. A ship propeller according to Claim 1 including the step of adding 2 to 10 percent aluminum to the copper base alloy.
- (C) 7. A ship propeller according to Claim 1 including 2 to 10 percent aluminum.
- (D) 7. A ship propeller according to Claim 1 wherein said alloy includes 2 to 10 percent aluminum.
- (E) None of the above.

The most correct answer is choice (E) because none of choices (A) – (D) would accord with proper PTO practice and procedure. Choice (A) is defective because it is misdirected to “a copper base alloy” while the claim it depends upon is directed to “a ship propeller.” Choice (B) is defective for two reasons. First, it purports to add a process step to a product claim. A claim directed to more than one statutory class of invention violates 35 U.S.C. § 112, second paragraph. Second, choice (B) purports to add aluminum to the copper base alloy of Claim 1. This is impermissible because Claim 1 recites “copper base alloy consisting of” (Emphasis added). The transitional phrase “consisting of” excludes any element, step or ingredient not specified in Claim 1. See MPEP § 2111.03 (“A claim which depends from a claim which ‘consists of’ the recited elements or steps cannot add an element or step”). Choice (C) is wrong because it purports to add “2 to 10 percent aluminum” to the propeller of Claim 1. Since the specification teaches the addition of aluminum to the copper base alloy, not to the propeller, choice (C) introduces new matter. Thus, choice (C) is subject to rejection under 35 U.S.C. § 112, first paragraph. See MPEP § 608.04. Choice (D) is wrong because it purports to include “2 to 10 percent aluminum” in the alloy in Claim 1. However, the alloy in Claim 1 is defined by the term “consisting of.” The transitional phrase “consisting of” excludes any element, step, or ingredient not specified in Claim 1.

The most correct answer is choice (E) and Petitioner selected choice (D).

Petitioner contends that choice (D) “is a more correct answer than the answer key ‘E’ because (1) “the question is fundamentally ambiguous, subjective and/or unfair (2) ‘D’ is a properly allowable claim, and is supported by the disclosure. Petitioner asserts that “‘E’ makes no sense because one or more of the other answers is a properly allowable claim” and “[c]ertainly ‘D’ is an allowable claim.”

Petitioner’s arguments are not persuasive. There is no foundation for Petitioner’s arguments concerning ambiguity, subjectivity, or fairness. Choice (D) is wrong because it purports to add an element to “said alloy.” Choice (D) fails to observe the “consisting of” limitation in the clause directed to the alloy. See Mannesmann Demag Corp. v. Engineered Metal Products Co., 793 F.2d 1279, 1282, 230 USPQ 45, 46 (Fed. Cir. 1986) (the phrase “consisting of” appearing in a clause limits the element set forth in the clause); see also MPEP 2111.03 (“When the phrase ‘consists of’ appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause; other elements are not excluded from the claim as a whole”). The transitional phrase “consisting of” excludes any element, step, or ingredient not specified in the copper base alloy of Claim 1. Thus, aluminum is excluded from the alloy. No error in grading has been shown. Petitioner’s request for credit on Question 9 is denied.

Question 10 reads as follows:

10. Applicant claims the following container lid combination:

1. A dispensing top for passing only several candy pieces at a time from an open ended container filled with candy, having a generally conical shape and an opening at each end, the opening at the reduced end allows several pieces of candy to pass through at the same time, and means at the enlarged end of the top embrace the open end of the container, the taper of

the top being such that only a few pieces of candy are dispensed when the top is mounted on the container and the container is turned over.

The prior art reference X teaches a conically shaped funnel that can be secured on top of a can containing motor oil, such that the contents are dispensed when the can is turned on its side. X also mentions that it can be used for solid materials. The claim was rejected as anticipated by X under 35 U.S.C. § 102. Which of the following replies to the rejection would be most likely to result in issuance of Claim 1?

- (A) Traversing the rejection on the ground that X is nonanalogous art, and therefore cannot be used for anticipation purposes against Claim 1.
- (B) Traversing the rejection on the ground that X does not specifically teach dispensing of candy pieces like Claim 1.
- (C) Amending Claim 1 to add specific limitations to the dimensions of the dispensing top.
- (D) All of the above.
- (E) None of the above.

Choice (C) is the most correct answer because amending the claim to add specific structural dimensions or other limitations is most likely to distinguish Claim 1 from prior art X. MPEP § 2114. Choice (E) is incorrect because an amendment such as proposed in choice (C) is likely to overcome the rejection and result in issuance of the claim. Choice (A) is incorrect because analogous art is not a consideration for an anticipation rejection under 35 U.S.C. § 102. See *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) (“the question whether a reference is analogous art is irrelevant to whether that reference anticipates”); MPEP § 2131.05. Choice (B) is incorrect because dispensing candy pieces as mentioned in Claim 1 is merely a functional description that does not structurally distinguish Claim 1 from X, which can be used to dispense liquids or solids. In *Schreiber*, claims directed to a funnel top for a popcorn dispenser were not successfully distinguished over a prior art oil funnel on the grounds that the claimed top was used for popcorn because the oil funnel inherently performs this function. *Schreiber*,

128 F.3d at 1479, 44 USPQ2d at 1433 (“declaration fails to show that [anticipating reference] inherently lacks the functionally defined limitations recited in claim”). Choice (D) is incorrect because choices (A) and (B) are incorrect.

Petitioner contends that “D is more correct than the answer key ‘C’.” Petitioner argues “(1) the question is fundamentally ambiguous, subjective and/or unfair (2) ‘D’ is the better answer because any competent practitioner would have certainly filed a reply utilizing all three of the arguments advanced in A, B and C, rather than limiting his or her response to merely ‘C’ [T]he model answer’s citation of [the *Schreiber*] case is not proper (3) The question should be deleted because of the very recent nature of the decision, and the likelihood that the case might be reversed or reviewed by a later panel. No question should be based on a 1997 appellate case (4) A decision of a U.S. Appeals Court is not binding on what the best procedure would be in answering this question”

Petitioner’s arguments are not persuasive. Petitioner fails to substantiate his contention that “the question is fundamentally ambiguous, subjective and/or unfair.” Petitioner’s argument about what any competent practitioner would do is not responsive to the call of the question which asks which of the given strategies is most likely to result in issuance of the claim. Contrary to Petitioner’s position, the facts and issue in the *Schrieber* case are precisely on point. Equally unpersuasive is Petitioner’s argument that “[n]o question should be based on a 1997 appellate case that for all we know, is subject to U.S. Supreme Court review now or in the future, not to mention subject to relitigation in the future.” It is the duty of registered agents and attorneys to be aware of current developments in pertinent case law and controlling legal authority.

See 37 C.F.R. §§ 10.76, 10.77, and 10.89(b)(1). In the *Schreiber* case, the Federal Circuit affirmed a decision by the Board of Patent Appeals and Interferences. Petitioner has not shown that there is any reason why this case should not apply. No error in grading has been shown. Petitioner's request for credit on Question 10 is denied.

Question 16 reads as follows:

16. An original claim in a patent application to a mechanical arts invention recites the limitation of "a screw" which is shown in an original application drawing. However, "a screw" does not appear in the original written description part of the application. Which of the following is correct?

- (A) The written description may not be properly amended to include "a screw."
- (B) The claim is indefinite with respect to "a screw."
- (C) The application lacks an enabling disclosure as to "a screw."
- (D) The claim is definite with respect to "a screw."
- (E) The application fails to set forth the best mode for "a screw."

The correct answer is choice (D) and Petitioner selected choice (C). Choice (D) is correct because MPEP § 2173.05(e) indicates that as long as a claim phrase has a reasonable degree of clarity a claim phrase is definite despite the lack of an explicit match to the words in the written description. The application as filed illustrated the meaning of "a screw" in an original application drawing. Choice (C) is incorrect because the application as filed provided an enabling disclosure of the limitation "a screw" by illustrating the limitation in an original application drawing.

Petitioner contends that "'(C)' is more correct than the answer key '(D)' because (1) the question is fundamentally ambiguous, subjective and/or unfair (2) 'C' is clearly the right answer because there is not an enabling disclosure as to the word 'screw' . . . (3) 'D' is NOT a correct answer because the claim is not definite as to a 'screw' as there are many types of screws and there should be a better limitation or definition or disclosure."

According to Petitioner, “[t]his claim cannot be allowable.” Petitioner maintains that “[n]o competent practitioner would fail to be more definite.”

Petitioner’s arguments are not persuasive. In order to enable a claimed invention, an applicant for patent must disclose the invention so that one of skill in the art can make and use the invention. 35 U.S.C. § 112, first paragraph. MPEP § 2164.05(b) demonstrates that ordinary skill in the mechanical arts is presumed when considering the question of enablement. See also *In re Sovish*, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985) (hypothetical person would apply such ordinary skill as he (or she) is presumed to possess). Petitioner argues that ordinary skill “is not relevant to whether a ‘screw’ has to be disclosed because a ‘screw’ is something that has to be disclosed whether one has ordinary skill in the mechanical arts or not.” Petitioner’s argument assumes its conclusion. Petitioner overlooks the drawing that illustrates and discloses details of the screw. Petitioner has not provided any reasoning to show that the disclosure of a screw in the original drawing fails to inform one skilled in the art how to make and use the invention having the limitation “a screw.” Petitioner argues that the claim is not definite and choice (D) is not correct. However, MPEP § 2173.05(e) states that “the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.” The facts show that while the limitation “a screw” lacks antecedent basis in the words of the description, the limitation is provided with antecedent basis in an original application drawing. While no words provide explicit antecedent basis, the claim is supported by the disclosure of the screw in the original drawing. Thus, the scope of a claim reciting “a screw” would be reasonably

ascertainable by those skilled in the mechanical arts and does not render the claim indefinite. Petitioner has provided no grounds in support of the additional conclusory assertions regarding ambiguity, subjectivity, and fairness. No error in grading has been shown. Petitioner's request for credit on Question 16 is denied.

Question 22 reads as follows:

22. Which of the following claims is (are) not in proper format?

- (A) A device for cooking small pieces of food comprising a basket including a mesh made of a material suitable for cooking small pieces of food, said mesh comprising a bottom, a rear wall, a front wall, and two side walls, wherein the two side walls are joined to the front and rear walls and the rear wall is higher than the front wall such that the entire device fits completely within conventional covered outdoor barbecue grills and such that the higher rear wall facilitates turning over the small pieces of food when the device is shaken.
- (B) A mesh basket for cooking food comprising a bottom, a rear wall, a front wall, and two side walls, wherein the side walls are joined to the front and rear walls and the rear wall is higher than the front wall such that the entire basket fits completely within conventional covered outdoor barbecue grills.
- (C) A device for grilling small pieces of food comprising a bottom, a rear wall, a front wall, and two side walls, wherein the two side walls are joined to the front and rear walls and the rear wall is higher than the front wall, and wherein the walls are made of a mesh material suitable for cooking or grilling small pieces of food.
- (D) (A) and (B).
- (E) None of the above.

The most correct answer is choice (E) because each of the claims in choices (A) – (C) is in proper format.

Petitioner argues that “‘D’ is more correct than answer key ‘E’ because (1) the question is fundamentally ambiguous, subjective and/or unfair (2) ‘D’ is the best answer because both ‘A’ and ‘B’ are not in proper format.” Petitioner argues that “‘E’ none of the above is . . . a double negative and results in meaning that A, B and C are all in proper

format.” Petitioner contends “the use of the double negative method of questioning is fundamentally improper and unfair, and ungrammatical, and calculated to be confusing.” Petitioner argues that “[t]he answer of ‘E’ is fundamentally ambiguous because ‘none of the above’ cannot be properly conjoined to answer ‘which of the . . . claims are not in proper format.’” Petitioner argues that “[u]pon review, the committee should discover that ‘A’ and ‘B’ are NOT in proper format”

Petitioner’s arguments are not persuasive. Choice (E) is not a double negative. Petitioner’s conclusory statement that “[u]pon review, the committee should discover that ‘A’ and ‘B’ are NOT in proper format” lacks any foundation. No error in grading has been shown. Petitioner’s request for credit on Question 22 is denied.

Question 23 reads as follows:

23. Which of the following statements is (are) true?

- (A) A claim may not be dependent on any claim which is itself a dependent claim.
- (B) A dependent claim may not contain means-plus-function limitations.
- (C) A dependent claim will always be infringed by any device that would also infringe the base claim from which it depends.
- (D) Any dependent claim may be re-drafted as an independent claim.
- (E) All of the above statements are true.

The most correct answer is choice (D) and Petitioner selected choice (C). The third paragraph of 35 U.S.C. § 112 states that “[a] claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.” See also 37 CFR § 1.75(c). Thus, any dependent claim may be rewritten as an independent claim by expressly including all of the limitations of the base claim to which it referred. See MPEP § 608.01(n), pages 600-63 (Claim Form and Arrangement).

Choice (C) is incorrect because a device that infringes a base claim may not necessarily contain the further limitation of a dependent claim.

Petitioner contends that “‘(C)’ is more correct than answer key ‘(D)’ because (1) the question is fundamentally ambiguous subjective and/or unfair (2) ‘C’ is literally always true . . . (3) ‘D’ is not a correct answer because 112 does not support it’s [sic] claim to validity and because the model answer does not explain why it’s correct. (4) ‘D’ is expressed in such tortured and poorly grammatical language that either it cannot be correct, or it is fundamentally unfair as a test question.” Petitioner reasons that “if the base claim is infringed, that means that something is common to both inventions, and therefore the dependent claim device is also possessing the same thing or things which are infringing the base claim.”

Petitioner’s arguments are not persuasive. Petitioner’s assertion that “[i]f the base claim is infringed, the dependent claim must also be infringed” is without merit. Contrary to Petitioner’s reasoning, the fact that a dependent claim has limitations in common with its base claim does not support a conclusion that the dependent claim is infringed whenever the base claim is infringed. A dependent claim adds further limitations to those contained in the base claim. Thus, it is possible that, even though a device might infringe a base claim, the dependent claim would not be infringed because the device does not meet the dependent claim’s additional limitations. Petitioner’s argument that choice (D) is not supported by 35 U.S.C. § 112 has no merit. Petitioner provides no reasons to support the conclusory assertions regarding ambiguity, subjectivity, fairness, and tortured language. No error in grading has been shown. Petitioner’s request for credit on Question 23 is denied.

Question 25 reads as follows:

25. Which of the following is false?

- (A) The meaning of terms in a claim should be ascertainable by reference to the description in the specification.
- (B) While a term used in a claim may be given a special meaning in the description, no term may be given a meaning repugnant to the usual meaning of the term.
- (C) Trademarks may be used in claims only if each letter in the trademark is capitalized.
- (D) Claims may not contain tables or chemical or mathematical formulas.
- (E) Figures may be incorporated by reference in the claims.

Both choices (C) and (D) contain false statements and are, therefore, correct answers. Choice (C) is a false statement because capitalization alone is not enough to constitute proper use of a trademark in a claim. Trademarks should be identified by capitalizing each letter of the mark. See MPEP § 608.01(v). However, as discussed in MPEP § 2173.05(u), a claim should be carefully analyzed to determine how a trademark is used in the claim. “If the trademark . . . is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph.” *Id.* citing *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). In such a case, the claim scope is uncertain since a trademark is a source identifier, not an identification of a particular material or product. “If a trademark . . . appears in a claim and is not intended as a limitation in the claim, the question of why it is in the claim should be addressed.” MPEP § 2173.05(u). Thus, it is not true that trademarks may be used in the claim **only if** each letter in the trademark is capitalized. Claims may contain chemical or mathematical formulas and, if necessary, may contain tables. 37 CFR § 1.58(a). Thus, choice (D) is a false statement.

Both choices (C) and (D) are correct answers and Petitioner selected choice (E). Petitioner contends that choice (E) is more correct “because (1) the question is fundamentally unfair, ambiguous and/or subjective (2) the question . . . should be deleted because there is more than one right answer given. . . . (3) ‘C’ and ‘D’ are not both false and therefore ‘C’ and ‘D’ are not correct answers. . . . (4) E is correct because the word ‘incorporate’ is fundamentally ambiguous and we do not know what this statement means, or that its meaning is broad enough to encompass false meanings as Quine or other logicians would understand that statement.”

Petitioner’s arguments are not persuasive. Petitioner’s assertions concerning fairness, ambiguity, or subjectivity have no foundation. Petitioner provides no reasoning in support of the conclusory assertion that choices (C) and (D) are not both false. Petitioner provides no evidence or reasoning to support the argument that the word “incorporate” is fundamentally ambiguous or that patent practitioners do not know what it means. See, e.g., Black’s Law Dictionary, abridged sixth edition (1991) (defining “incorporate” as “to declare that another document shall be taken as part of the document in which the declaration is made as much as if it were set out at length therein”; defining “incorporation by reference” as “the method of making one document of any kind become a part of another separate document by referring to the former in the latter, and declaring that the former shall be taken and considered as a part of the latter the same as if it were fully set out therein”). A patent practitioner should be aware that MPEP § 2173.05(s) states “[i]ncorporation [into a claim] by reference to a specific figure or table . . . ‘is permitted only in exceptional circumstances Incorporation by reference is a necessity doctrine, not for applicant’s convenience,’” quoting *Ex parte Fressola*, 27 USPQ2d 1608,

1609 (Bd. Pat. App. & Int. 1993) (citations omitted). Thus choice (E) is a true statement and cannot be a correct answer to the question asked. No error in grading has been shown. Petitioner's request for credit on Question 25 is denied.

Question 27 reads as follows:

27. Applicant filed a patent application claiming a polyester. The application discloses that the claimed polyester having structural formula R-R' is used to form a stain resistant fabric. The examiner properly rejected the claims as unpatentable over prior art disclosing the claimed polyester having structural formula R-R' and its use to form various fabrics. Given the fact that applicant's specification discloses that the polyester may be produced by a process comprising steps A, B, C, and D, and such process is novel and unobvious, which of the following claims, if introduced by amendment, would overcome the rejection?

- (A) A polyester having structural formula R-R' used to form a stain resistant fabric, the polyester being produced by the process comprising the steps A, B, C, and D.
- (B) A polyester-producing process comprising steps A, B, C, and D, said process resulting in a polyester having structural formula R-R' capable of forming a stain resistant fabric.
- (C) A polyester produced by the process comprising the steps A, B, C, and D.
- (D) A polyester comprising the resultant product of steps A, B, C, and D.
- (E) A polyester produced by the process comprising the steps A, B, C, and D, said polyester used to form a stain resistant fabric and having structural formula R-R'.

The correct answer is choice (B) and Petitioner selected choice (C). Choice (B) is correct because it is directed to the novel and unobvious process. Choice (C) is wrong because it claims the product in product-by-process format, whereas the novelty is in the process, not the product. "[E]ven though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself The patentability of a product does not depend on its method of production. If the product in a product-by-process claim is the same as or obvious from a product of the

prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted); *Ex parte Edwards*, 231 USPQ 981, 981 (Bd. Pat. App. & Int. 1986); MPEP § 2113.

Petitioner argues that (1) the “question is fundamentally unfair, ambiguous and/or subjective (2) the answers are in conflict with the MPEP or applicable law (3) there is no right answer or more than one right answer and the question should be deleted (4) because Petitioner’s answer is right and the model answer key question is wrong. According to Petitioner, “the answer ‘C’ is right because it is a proper process claim and because ‘B’ is not a proper claim.”

Petitioner’s arguments are not persuasive. Petitioner’s assertions concerning fairness, ambiguity, and subjectivity are without foundation. Petitioner’s conclusory assertions concerning conflict with the MPEP or applicable law are unsupported. See authorities cited above. Petitioner fails to offer any evidence or reasoning supporting either of his alternative contradictory assertions that there is no right answer or that there is more than one right answer. Contrary to Petitioner’s assertion, choice (C) is not a process claim because it is directed to a product. No error in grading has been shown. Petitioner’s request for credit on Question 27 is denied.

Question 30 reads as follows:

30. Which of the following requirements of 35 U.S.C. § 112 do NOT apply to design patent claims?

- (A) The written description requirement of the first paragraph.
- (B) The best mode requirement of the first paragraph.
- (C) The requirement in the second paragraph to distinctly claim the subject matter which the applicant regards as his invention.

- (D) The requirement in the third paragraph for an independent claim.
- (E) None of the above.

Choice (E) is correct. 35 U.S.C. § 171 provides “[t]he provisions of this title relating to patents for inventions shall apply to patents for designs except as otherwise provided.”

The correct answer is choice (E) and Petitioner selected choice (C). Petitioner contends that “‘(C)’ is more correct than answer key ‘E’ because (1) the question is fundamentally unfair, ambiguous and/or subjective (2) the answer is in conflict with the MPEP or applicable law (3) ‘E’ is ambiguous . . . resulting in an ambiguous and misleading double negative (4) ‘(C)’ is correct since the requirement does not apply to design patent claims.”

Petitioner’s arguments are not persuasive. Petitioner’s arguments concerning fairness, ambiguity, and subjectivity lack any support. Petitioner provides no foundation for the assertion that the Model Answer conflicts with the MPEP or applicable law. There is no double negative in the question, and Petitioner fails to identify anything ambiguous or misleading in the question. Petitioner’s choice (C) refers to the second paragraph requirement of section 112. Petitioner fails to identify where it is “otherwise provided” that the requirement in the second paragraph of 35 U.S.C. § 112 does not apply to design patents. Petitioner’s blanket statement that “the requirement does not apply to design patents” is wrong. No error in grading is shown. Petitioner’s request for credit on Question 30 is denied.

Question 35 reads as follows:

35. Given the following information regarding three claims:

- (i) A claim refers to “said lever” where the claim contains no earlier recitation or limitation of a lever;
- (ii) A claim initially refers to “an aluminum lever,” and “a plastic lever” and thereafter refers to “said lever”; and
- (iii) A claim initially refers to a “controlled stream of fluid” and thereafter refers to “the controlled fluid,”

which of the following statements is correct?

- (A) The claims (i), (ii) and (iii) are all definite.
- (B) The claims (i) and (ii) are definite; and the claim in (iii) is indefinite.
- (C) The claim (i) is indefinite; and the claims in (ii) and (iii) are definite.
- (D) The claims (i) and (ii) are indefinite; and the claim in (iii) is definite.
- (E) The claims in (i), (ii) and (iii) are all indefinite.

The most correct answer is choice (D) because the scope of Claim (iii) is reasonably ascertainable by those skilled in the art, but neither Claim (i) nor Claim (ii) provides clear antecedent basis for “said lever.” See *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Int. 1992) (“controlled stream of fluid” provided reasonable antecedent basis for “the controlled fluid”). This question was constructed using three examples discussed in the first paragraph of MPEP § 2173.05(e) “Lack of Antecedent Basis” as the models for Claims (i), (ii), and (iii).

The most correct answer is choice (D) and Petitioner selected choice (E). Petitioner contends that “‘E’ is more correct than answer key ‘D’ because (1) the question is fundamentally unfair, ambiguous and/or subjective (2) the answer is in conflict with the MPEP or applicable law (3) ‘E’ is correct because all of the claims are indefinite.” According to Petitioner, “Claim (iii) is NOT definite, contrary to the model answer key.”

Petitioner's arguments are not persuasive. Petitioner provides no explanation of the assertions concerning fairness, ambiguity, or subjectivity. Since the question was constructed with three examples provided by the MPEP on this topic, there is no basis for Petitioner's assertions. Petitioner's conclusory argument regarding conflict with the MPEP or applicable law is in error for the reasons given above citing the MPEP and *Porter*. MPEP § 2173.05(e) quotes *Porter* as authority. Petitioner's assertion that Claim (iii) is indefinite is contrary to controlling authority that held the opposite. No error in grading has been shown. Petitioner's request for credit on Question 35 is denied.

Question 37 reads as follows:

37. Which of the following expressions, when found in a claim, comply with the provisions of the second paragraph of 35 U.S.C. § 112?

- (A) containing A, B, and optionally C
- (B) material such as rock, wool or asbestos
- (C) lighter hydrocarbons, such, for example, as the vapors or gas produced
- (D) normal operating conditions such as while in the container of a proportioner
- (E) such material as wood and the like

The most correct answer is choice (A). The word "optionally" may be used when there is no ambiguity as to which alternatives are covered by the claim. See MPEP § 2173.05(h)III. Each of choices (B), (C), (D), and (E) are prima facie indefinite because they set forth a broad term but mention a narrower range with the exemplary language "such as," "such, for example, as" or "such . . . as." The stated examples and preferences lead to confusion over the intended scope of the claim. It is not clear if the narrower range is a limitation of the broader term. See MPEP § 2173.05(d). Accordingly, choices (B), (C), (D), and (E) fail to comply with 35 U.S.C. § 112, second paragraph.

The most correct answer is choice (A) and Petitioner selected choice (B).

Petitioner contends that “B” “is more correct than answer key ‘A’ because (1) the question is fundamentally unfair, ambiguous and/or subjective (2) the answer is in conflict with the MPEP or applicable law (3) ‘A’ is indefinite and not a proper phrase (4) ‘B’ is definite and a proper phrase (5) There is no right answer to this question and the question should be deleted, or there are more than one right answer and the question should be deleted.”

Petitioner’s arguments are not persuasive. Contrary to Petitioner’s position, choice (A) is definite and accords with MPEP § 2173.05(h), part (III) and the applicable law cited therein. Choice (B) is *prima facie* indefinite for the reasons stated above. Petitioner’s arguments concerning fairness, ambiguity, and subjectivity are without basis and fail to establish that an error in grading has occurred. There is only one correct answer to this question. No error in grading has been shown. Petitioner’s request for credit on Question 37 is denied.

Question 39 reads as follows:

39. Which of the following statements regarding establishment of a *prima facie* case of obviousness is not correct?

- (A) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- (B) There must be a reasonable expectation of success.
- (C) The prior art reference (or references when combined) must teach or would have suggested all the limitations in the claim.
- (D) The teaching or suggestion to make the claimed combination that is found in the applicant’s disclosure may be used by the examiner.
- (E) The prior art references when combined, cannot render the prior art unsatisfactory for its intended purpose.

The answer is choice (D). Choice (D) is not a correct statement because one cannot look to the applicant's disclosure to find the motivation or suggestion to combine references. See MPEP § 2143.

The most correct answer is choice (D) and Petitioner selected choice (E). Petitioner contends that choice (E) "is more correct than answer key 'D' because (1) the question is fundamentally unfair, ambiguous and/or subjective (2) the answer is in conflict with the MPEP or applicable law (3) 'D' is not a correct or right answer because certainly a teaching in the disclosure can be used to establish prior art or obviousness (4) 'E' is a correct answer because it is not false (5) there is not right answer or more than one right answer and the question should be deleted."

Petitioner's arguments are not persuasive. Petitioner fails to specify how the question is "fundamentally unfair, ambiguous and/or subjective." Petitioner's argument that choice (D) is in conflict with the MPEP or applicable law is wrong. MPEP § 2143 provides that "[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure," citing *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Petitioner's argument concerning what a teaching in the disclosure can be used to establish regarding prior art ignores the meaning of "applicant's disclosure" in choice (D). (Emphasis added). Petitioner's argument about the disclosure ignores the term "applicant's disclosure". (Emphasis added). The fact that choice (E) is not false means it cannot be the correct answer to a question that asks one to identify the false statement. Petitioner's arguments are without basis and fail to establish that an error in grading has occurred. Petitioner's request for credit on Question 39 is denied.

Question 43 reads as follows:

43. Patent practitioner Smith filed a patent application for adhesive compositions having a paste-like consistency and comprising filler admixed with liquid monomer, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer. The specification states, "The compositions of this invention must contain, as essential ingredients, at least one monomer of a class of alpha-cyanoacrylic acid esters and at least one filler." The compositions are characterized as being capable of being applied to a substrate submerged in water. Which of the following claims properly sets forth the composition?

- (A) An adhesive composition comprising a filler admixed with a liquid monomer of a class known as alpha-cyanoacrylic acid esters, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer.
- (B) An adhesive composition comprising means to admix a filler with a liquid monomer of a class known as alpha-cyanoacrylic acid esters, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer.
- (C) An adhesive composition comprising a filler for admixture with a liquid monomer of a class known as alpha-cyanoacrylic acid esters, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer.
- (D) An adhesive composition having a filler adapted to be admixed with a liquid monomer of a class known as alpha-cyanoacrylic acid esters, the filler being water-insoluble solid filler which forms a paste with the liquid monomer, and is essentially inert with respect to the monomer and is insoluble in the monomer.
- (E) An adhesive composition assembly having a paste-like consistency capable of being applied to a substrate submerged in water.

The correct answer is choice (A) because it is the only claim that recites the invention as it was described in the specification. Only choice (A) claims the filler admixed with a liquid monomer including the essential ingredients identified in the specification. 35 U.S.C. § 112, first paragraph; *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976); MPEP §§ 2164.08(c) and 2174. Choices (B) through (E) are wrong

because they fail to claim the composition of an admixture of a filler and the essential ingredient, alpha-cyanoacrylic acid esters.

The most correct answer is choice (A) and Petitioner selected choice (C).

Petitioner contends that “Petitioner’s answer on question [43 is] more correct than the answer key responses because (1) the question is fundamentally unfair, ambiguous and/or subjective (2) the answers are in conflict with the MPEP or applicable law (3) there is no right answer or more than one right answer and the question should be deleted (4) because Petitioner’s answer is right and the model answer key is wrong.” Petitioner states “[o]n 43, ‘C’ is right and ‘A’ is wrong because ‘A’ is not right and ‘C’ is right.”

Petitioner’s arguments are not persuasive. Petitioner fails to specify how the question is “fundamentally unfair, ambiguous and/or subjective.” Petitioner’s argument concerning a conflict with the MPEP or applicable law is wrong. Petitioner fails to identify any error in the MPEP sections or case citations in the model answer. Petitioner’s positions are without merit and are based on inadequate authority. The model answer explains that choice (C) fails to properly set forth the described composition because it is directed to a “filler for admixture” rather than a composition comprising the described “filler admixed.” No error in grading has been shown. Petitioner’s request for credit on Question 43 is denied.

Question 46 reads as follows:

46. On January 15, 1996, Winter filed a patent application disclosing and claiming a process for promoting growth of a ruminant by administering a pharmacologically acceptable salt of lysocellin to said ruminant. In the application, physiologically acceptable salts of lysocellin are identified as sodium lysocellin, zinc lysocellin, and manganese lysocellin. The claims in the application are as follows:

1. A process for promoting growth of a ruminant by administering to said ruminant a growth-promoting amount of a pharmaceutically acceptable salt of lysocellin selected from the group consisting of manganese lysocellin, sodium lysocellin and zinc lysocellin.
2. The process of Claim 1 wherein the pharmaceutically acceptable salt of lysocellin is manganese lysocellin.
3. The process of Claim 1 wherein the pharmaceutically acceptable salt of lysocellin is sodium lysocellin.
4. The process of Claim 1 wherein the pharmaceutically acceptable salt of lysocellin is zinc lysocellin.

Claims 1-4 in Winter's application have been twice rejected under 35 U.S.C. § 103 over a U.S. patent granted to Spring on April 15, 1997, on an application filed March 12, 1996; which, in turn is a continuation-in-part application of an application filed December 12, 1994, now abandoned. The second rejection is a final rejection. As filed on December 12, 1994, Spring's application disclosed and claimed a "process for promoting growth of ruminants by administering to ruminants a growth promoting amount of manganese lysocellin," as well as how to make and use the invention, and the best mode for carrying out the invention. As filed on March 12, 1996, Spring's CIP application disclosed and claimed a "process for promoting growth of ruminants by administering to ruminants a growth promoting amount of a member selected from the group consisting of manganese lysocellin, sodium lysocellin, and zinc lysocellin." The CIP application also discloses how to make and use the invention, and the best mode for carrying out the invention. Claim 1 in Spring's patent claims a "process for promoting growth of a ruminant by administering to the ruminant a growth promoting amount of a lysocellin material selected from the group consisting of manganese lysocellin, sodium lysocellin, and zinc lysocellin." The rejection may be properly obviated by:

- (A) A timely appeal of the rejection of Claims 1-4 to the Board of Patent Appeals and Interferences, a timely filed brief stating that the claims stand or fall together, and arguing that Spring's parent application only discloses administering the manganese lysocellin, and Spring's patent does not present a claim confined to administering a manganese lysocellin, and timely payment of all appropriate fees.
- (B) A timely appeal of the rejection of Claims 1-4 to the Board of Patent Appeals and Interferences, a timely filed brief stating that the claims stand or fall together, and arguing that Spring's patent claims are unsupported by the disclosure in the parent application

because the description of one species, the manganese lysocellin, in Spring's parent application does not amount to a written description of the class of materials or genus set forth in Spring's patent claims, and timely payment of all appropriate fees.

- (C) A timely filed reply arguing that Spring's patent claim is unsupported by the disclosure in the parent application because the description of one species, the manganese lysocellin, in Spring's parent application does not amount to a written description of the class of materials or genus set forth in Spring's patent claims.
- (D) A timely filed reply containing an amendment canceling "manganese lysocellin," in Claim 1, and arguing that Spring's patent claim does not describe the invention now claimed in Winter's application, and that there is nothing in Spring's parent application disclosing or motivating one of ordinary skill in the art to promote growth of ruminants with sodium lysocellin or zinc lysocellin.
- (E) A timely filed reply containing an amendment cancelling "manganese lysocellin," in Claim 1, and cancelling Claim 2, and arguing that there is nothing in Spring's parent application disclosing or motivating one of ordinary skill in the art to promote growth of ruminants with sodium lysocellin or zinc lysocellin.

Choice (E) is correct because the cancellation of the manganese limitation in Claim 1 and the cancellation of Claim 2 obviate the rejections with respect to these claims. Since the use of sodium or zinc lysocellin is not disclosed in Spring's parent application, the argument presented in choice (E) properly addresses the lack of disclosure and motivation to use sodium or zinc lysocellin in the process. MPEP § 201.11, pages 200-31 (See "When Not Entitled to Benefit of Filing Date"); and MPEP § 2136.03, part (d).

The most correct answer is choice (E) and Petitioner selected choice (B). Petitioner contends that "'E' is not right and 'B' is right and therefore the right answer is given." According to Petitioner, "Petitioner's answer on question [46 is] more correct than the answer key responses because (1) the question is fundamentally unfair, ambiguous and/or subjective (2) the answers are in conflict with the MPEP or applicable

law (3) there is no right answer or more than one right answer and the question should be deleted (4) because Petitioner's answer is right and the model answer key is wrong."

Petitioner's arguments are not persuasive. Petitioner's conclusory statement that "'E' is not right and 'B' is right" is not sufficient to establish an error in grading. With respect to choice (B), the process using manganese lysocellin is fully described within the meaning of 35 U.S.C. § 112, first paragraph, in Spring's parent application, and the description of a single embodiment of a broadly claimed subject matter constitutes a description of the invention for anticipation purposes. *In re Lukach*, 442 F.2d 967, 970, 169 USPQ 795, 797 (CCPA 1971); MPEP §§ 201.11 and 2163.05, part b. Anticipation is the epitome of obviousness. Since Spring teaches the manganese lysocellin of Winter's claims 1 and 2, Winter's appeal cannot succeed in overcoming the rejection of claims 1 and 2. Because the conditions in choice (B) state that all claims stand or fall together, the appeal could not succeed in overcoming the rejection of Claims 3 and 4. Thus choice (B) fails to obviate the rejection and choice (B) cannot be a correct answer. No error in grading has been shown. Petitioner's request for credit on Question 46 is denied.

Additional Arguments Presented:

In addition to individually challenging the 18 questions discussed above, Petitioner contends that "Petitioner is entitled to a greater score for any or all of" a list of reasons.

Petitioner's additional reasons are not persuasive. As provided by the pertinent rule, "[e]xcept as provided in this paragraph, each Petitioner for registration must take and pass an examination which is held from time to time." 37 C.F.R. § 10.7(b). Petitioner's general arguments that the questions are unfair or improper or "not capable of objective resolution by average members of the patent bar" are not persuasive for the reasons

explained above concerning the particular questions. Petitioner's incorporation by reference of unspecified arguments by unspecified others is unpersuasive because "[a]ny Petitioner requesting regrading shall particularly point out the error which the Petitioner believed occurred in the grading of his or her examination." 37 C.F.R. § 10.7(c).

Petitioner's general arguments fail to establish an error in grading. The questions tested knowledge of patent practice and were directed to appropriate subject matter. The exam, although difficult, fairly evaluated the examinees.

Being required to take the entire examination is not unfair to Petitioner, nor is it a deprivation of a property interest without due process of law. Prior to the deadline for filing applications to take the examination, all Petitioners were given notice in the General Requirements Bulletin for the August 26, 1998, Registration Examination of the changed vehicle for complying with 37 C.F.R. § 10.7(b). The Bulletin, under the heading "CONTENT OF THE EXAMINATION," contains the following relevant information:

NOTE: Anyone who has not passed both sections of the examination prior to or upon taking the August 1998 examination will be required to retake the entire examination, including any section passed. The August 1998 examination will be the last examination where individual scores are given for the morning and afternoon sections. The registration examinations beginning in 1999 will receive one score only and will test all applicable material throughout the examination.

Bulletin at p.4.

The General Requirements Bulletin sets forth policies for complying with the provisions of 37 CFR § 10.7, including the requirement to "take and pass an examination which is held from time to time." Accord *Premysler v. Lehman*, 37 USPQ2d 1057, 1059 (Fed. Cir. 1995) ("the Commissioner promulgated the General Requirements Bulletin to

interpret [37 CFR § 10.7(a)(2)(ii)].” Occasionally, the Bulletin describes changes in the manner by which compliance is to be achieved. *Premysler*.

The change regarding not being allowed to retake only the section failed applies equally to all petitioners taking and failing the August 26, 1998, examination regardless of the number of times they have applied for admission to the examination. Indeed, previous petitioners who failed one or both sections of the previous examination, like new petitioners, would be required to take the entire examination if they did not pass the examination given on August 26, 1998. Moreover, all petitioners who did not receive a passing score on one or both sections of the August 26, 1998, examination could petition for regrade in accordance with 37 CFR § 10.7(c). Thus, Petitioner was not disadvantaged over previous petitioners who took the same examination. Petitioner had an opportunity to learn of the changed vehicle in the General Requirements Bulletin, which was published long before he received the package informing him of his examination results and the necessity for him to retake the entire examination.

Inasmuch as the examination will now test all subject matter throughout the examination, it is not possible to take only “a special examination lasting three hours consisting only of claims-related questions, and that the pass rate on said exam be fixed at a certain level.”

All registered agents and attorneys must be “possessed of the necessary qualifications to render to applicants or other persons, valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.” 35 U.S.C. § 31. Petitioner and all others, pursuant to 37 CFR § 10.7(b), had an equal opportunity to pass the examination with scores of at least 70 on each section.

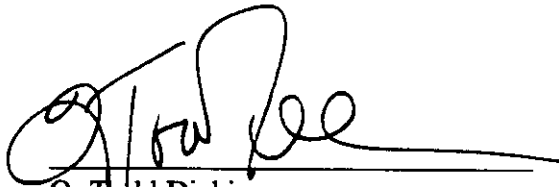
Petitioner and all other persons who did not pass the examination had an equal opportunity to demonstrate any errors in the grading pursuant to 37 CFR § 10.7(c). Petitioner's circumstances are not unlike those of every other petitioner taking the August 1998 examination or requesting regrade. Accordingly, Petitioner's request for a special examination is denied.

ORDER

For the reasons given above, four points have been added to Petitioner's score in the Afternoon Section of the Examination. Therefore, Petitioner's score is adjusted to 68. This score is insufficient to pass the Afternoon Section of the Examination.

Upon consideration of the petition for a passing grade on the Afternoon Section of the Registration Examination, it is ORDERED that the petition is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Q. Todd Dickinson', is written over a horizontal line.

Q. Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks